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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,332	12/08/2003	John W. Rohrer		5081

7590

12/01/2005

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,332

Applicant(s)

ROHRER, JOHN W.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-19 is/are pending in the application.
- 4a) Of the above claim(s) 4,7,8,11 and 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, 9, 10, 12, 13 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5-6, 9-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Downey.

Downey discloses a golf club grip (Title) including two or more hard or rigid vibration transmitting elements in the form of two protrusions (Ref. No. 20, Figs. 6-7, Col. 3, Lns. 57-60) in intimate contact with a shaft and a golfer's hand or hands (Fig. 6), elements being selectively positioned with a grip at locations where transmission are desired to be greatest in the form of there will always be vibrations on a handle when a club hits a ball hard enough and this is were Downey placed the elements, elements omitted at locations where undesirable impact vibrations are greatest in the form of where Downey chose to not place the elements and placed softer material (Ref. Nos. 14, 18, Figs. 6-7), a grip area around elements having a layer of softer material which at least partially insulate or absorb the undesirable impact vibrations (Ref. Nos. 14, 18, Figs. 6-7, Col. 9, Lns. 55-60), elements being metal (Col. 4, Lns. 11-13), an element

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being an other symmetrical shape in the form of a triangle (Fig. 5), an element being embedded through a softer rubber (Fig. 6, Col. 4, Lns. 3-12), a slip-on type grip (Fig. 5), and an element is flush with a surface of a softer grip material (Fig. 6).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downey in view of Kobayashi.

Downey lacks an element being attached to a shaft prior to placing a softer grip material around an element. Kobayashi discloses attaching an inner jacket prior to placing a softer elastomer material around the inner jacket (Col. 3, Lns. 42-49). In view of the patent of Kobayashi it would have been obvious to modify the grip of Downey to have an element being attached to a shaft prior to placing a softer grip material around an element in order to simplify the assembly process by not having to use a mandrel and then take the grip off a mandrel and then place it on a shaft.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downey in view of Bloom.

Downey lacks a shaft back weighted within four inches of the top with lead or tungsten in such a manner to relocate vibration to elements on a grip. Bloom discloses a shaft back weighted within four inches of the top (Figs. 2, 4) with lead or tungsten (Col. 4, Lns. 51-53) in such a manner which would relocate vibration on a grip in the form that this device will change the vibration profile felt along a grip and lessen it near the end (Col. 5, Lns. 6-13) in order to have frictionally dissipative vibration damping counterweights (Title). In view of the patent of Bloom it would have been obvious to modify the grip of Downey to be part of a club with a shaft back weighted within four inches of the top with lead or tungsten in such a manner to relocate vibration to elements on a grip in order to both adjust the swing weight of a club while also reducing vibrations for a golfer who needs both.

Response to Arguments

6. The argument that the reference of Downey is improper in that Downey never teaches, claims or ever references impact vibrations much less selective impact vibration transmission from a head to hands is disagreed with. The grip of Downey is able to perform the function described. It can be placed such that elements are where it is desirable to have the greatest vibrations transmitted and elements are omitted where vibrations are undesirable. Plus since Downey designed the grip with the structure it has, the elements are positioned where is it desirable to have greater vibrations since the elements are more rigid and elements are omitted where it is desirable to not to

have greater vibrations. Downey would not have formed the grip as disclosed if the vibration profile was not desirable. Since Downey designed the grip, all the characteristics of this grip are desirable including the vibration absorption profile (vibration paths which pass on vibrations (elements) and vibration obstacles which omit vibrations (soft rubber)) and the torsional profile. The argument that it is improper to use the reference of Downey since Downey discloses projections and not multiple elements is disagreed with. On page 11 lines 16-18 in the specification of this application and in claim 17 the terminology is used of a tube 18 of elements 4 being integral with each other and cast or molded. The examiner is using the same terminology used in the specification. The examiner recommends being more specific in defining the elements so that they would not read on Downey using terminology as defined and used in the specification (i.e. a plurality of elements which directly contact only a golf club shaft and a softer grip material around each of the elements when a grip is applied to a shaft). The argument that it is improper to use Bloom with the motivation to lessen vibrations since claim 19 increases vibration at the hands is disagreed with. Claim 19 always also to relocate the vibrations to the elements on a grip. Clearly the invention of Bloom will change the vibration profile when used with a grip of Downey and as such will relocate the vibrations at the elements compared to a grip of Downey without a device of Bloom. Relocation of vibrations would include moving smaller amplitude vibrations to the elements. If it is desired to limit claim 19 to only the result of increasing vibration at elements than the claims need to be amended to remove the words "or relocate".

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/22 November 2005


STEPHEN BLAU
PRIMARY EXAMINER